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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,289	04/05/2001	Patricio Abarzua	469290-55	5725

7590 06/11/2002

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EXAMINER

FREDMAN, JEFFREY NORMAN

ART UNIT

PAPER NUMBER

1637

DATE MAILED: 06/11/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/827,289	ABARZUA, PATRICIO	
Examiner	Jeffrey Fredman	Art Unit	1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 4/06/01.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-30 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) \_\_\_\_\_ is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) 1-30 are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-29, drawn to methods of detection, classified in class 435, subclass 6.
  - II. Claims 30, drawn to kits, classified in class 435, subclass 810.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions in Group II and in Group I are related as product and process of use.

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product, which is a kit which comprises oligonucleotides and a polymerase may be used in the method of Group II, in nucleic acid synthesis methods, in nucleic acid degradation methods, in PCR, or in a variety of other DNA based methods.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. In order to be perfectly clear, the following subgroups within the Group I are NOT species elections. These are independent and distinct because each Allele specific nucleic acid is structurally and functionally distinct from each other Allele specific nucleic acid and molecules containing said allele. The chemical structure of each

polymorphism and of each molecule containing the same differ from each other. For example, a polynucleotide comprising allele 1 is chemically, structurally, and functionally different from a molecule comprising allele 2.

Restriction Subgroup I – SEQ ID NO: 1

Restriction Subgroup II – SEQ ID NO: 2

Restriction Subgroup III – SEQ ID NO: 3

Restriction Subgroup IV – SEQ ID NO: 4

Restriction Subgroup V – SEQ ID NO: 11

Restriction Subgroup VI – SEQ ID NO: 12

Restriction Subgroup VII – SEQ ID NO: 13

Restriction Subgroup VIII – SEQ ID NO: 14

Restriction Subgroup IX – SEQ ID NO: 15

Restriction Subgroup X – SEQ ID NO: 16

Restriction Subgroup XI – SEQ ID NO: 17

Restriction Subgroup XII – SEQ ID NO: 18

Restriction Subgroup XIII – SEQ ID NO: 19

Restriction Subgroup XIV – SEQ ID NO: 20

Restriction Subgroup XV – SEQ ID NO: 21

Restriction Subgroup XVI – SEQ ID NO: 22

Restriction Subgroup XVII – SEQ ID NO: 23

Restriction Subgroup XVIII – SEQ ID NO: 24

Restriction Subgroup XIX – SEQ ID NO: 25

Restriction Subgroup XX – SEQ ID NO: 26

Restriction Subgroup XXI – SEQ ID NO: 27

Restriction Subgroup XXII – SEQ ID NO: 28

Restriction Subgroup XXIII – SEQ ID NO: 29

Restriction Subgroup XXIV – SEQ ID NO: 30

Restriction Subgroup XXV – SEQ ID NO: 34

Restriction Subgroup XXVI – SEQ ID NO: 35

5. A telephone call was made to Alan Grant on June 7, 2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Fredman whose telephone number is 703-308-6568. The examiner can normally be reached on 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 703-308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Jeffrey Fredman  
Primary Examiner  
Art Unit 1637

June 7, 2002